UNITED STATES PATENT AND TRADEMARK OFFICE

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EXAMINER
KARMIS, STEFANOS

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte GRAHAM RUSSELL, JOHN D. CAIN, and
LIANNE C. FRANKLIN

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Appeal 2009-000811
Application 09/665,846
Technology Center 3600

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Before JENNIFER D. BAHR, JOHN C. KERINS, and
STEFAN STAICOVICI, *Administrative Patent Judges.*

STAICOVICI, *Administrative Patent Judge.*

DECISION ON APPEAL[1]

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[1] The two-month time period for filing an appeal or commencing a civil
action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing,
as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE"
(paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery
mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Graham Russell et al. (Appellants) appeal under 35 U.S.C. § 134 from the Examiner's decision rejecting claim 27 under 35 U.S.C. § 102(e) as anticipated by Garner (US 6,863,214 B2, issued Mar. 8, 2005) and claim 25 under 35 U.S.C. § 103(a) as unpatentable over Garner and Foley (US 6,381,342 B2, issued Apr. 30, 2002). We have jurisdiction over this appeal under 35 U.S.C. § 6.

THE INVENTION

Appellants' invention relates to a method of operating an image-based item processing system having a central processing site 20 and a number of branches 30A … 30N connected via a network 40 with the central processing site 20. The method includes capturing images of items at a branch without using physical tracer items, transferring the images captured to the central processing site 20, and processing the images at the central processing site using logical tracer items. Spec. 3, ll. 19-24 and fig. 1.

Claim 25 is representative of the claimed invention and reads as follows:

> 25. A method of operating a distributed image capture proof-of-deposit system having a central processing site and a number of branches connected via a network with the central processing site, the method comprising:
>
> capturing at a branch images of physical document items without use of a group of physical tracer document items;
>
> transferring the captured images of physical document items from the branch via the network to the central processing site;

receiving at the central processing site the images transferred from the branch;

assigning a unique entry number to all batches of document items received from the branch during a predetermined period of time;

creating a group of non-physical, logical tracer document items based upon the assigned unique entry number; and

associating the group of non-physical, logical tracer document items with the batches of document items received from the branch during the predetermined period of time; and

processing the batches of document items received from the branch during the predetermined period of time by using the group of non-physical, logical tracer document items which has been associated with the batches of document items received from the branch during the predetermined period of time.

SUMMARY OF DECISION

We REVERSE.

ANALYSIS

Independent claim 25 is drawn to a method of operating a distributed image capture proof-of-deposit system that includes "capturing at a branch images of physical document items without use of a group of physical tracer document items." Br., Claims Appendix. Similarly, claim 27 is drawn to a method of operating an encoding workstation "without using a group of physical tracer document items." *Id.* Specifically, claim 27 requires a first step of "determining whether a group of physical tracer document items is included in a tray of physical document items," and when not included, a

second step of "associating a unique group of non-physical, logical tracer document items with the tray of physical document items." *Id.*

Appellants argue that, in contrast to the claimed invention, "Garner uses physical tracer document items in the document trays." Br. 5. According to Appellants, "the tracer group slips being processed are actual physical document items." *Id.* In response, the Examiner takes the position that the system of Garner "merely takes a digitized image of the document and stores the image," and hence, "the image is captured without the use of a group of physical tracer document items." Ans. 9. The Examiner further posits that in Garner "there are times when the document is processed directly to system reject pockets or [an] alternate reject pocket without a group of physical tracer documents based on any entry such as the prime pass entry." Ans. 7.

We disagree with the Examiner's position because Garner specifically teaches that "[t]he first documents that enter the document processor 14 are the tracer slips"[2] and that individual financial documents 12 follow the tracer slips. Garner, col. 3, ll. 16-17 and 60-61. We agree with Appellants that, "the tracer group slips being processed are actual physical document items." Br. 5. We further find that Garner teaches a document processor 14 that "captures data encoded on the financial documents and an image of the financial documents during a prime pass, and assigns a prime pass sequence number to each financial document." Garner, col. 1, ll. 49-53 and fig.

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[2] The tracer-group slips are placed in front of the documents that form a tracer group, and serve to separate and identify the tracer group within the pockets. Garner, col. 2, ll. 54-57 and col. 3, ll. 19-21.

Although we appreciate the Examiner's position that when the image of a financial document is recaptured (because it needs to be repaired) tracer slips are not needed, nonetheless, Garner teaches that the repaired image is stored in a computer in association with its corresponding prime pass sequence number. *Id.*, col. 1, l. 59 through col. 2, l. 3. *See also*, Garner, col. 6, ll. 1-56. As such, since Garner's system (1) processes each financial document based upon its unique prime pass sequence number, (2) each prime pass sequence number is assigned to each document after it has passed through processor 14 and, (3) the first documents that enter the processor 14 are the tracer slips, we agree with Appellants that Garner does not teach, "capturing at a branch images of physical document items *without* use of a group of physical tracer document items," as called for by claim 25. Emphasis added. The addition of Foley does not remedy the deficiencies of Garner discussed above. Accordingly, the rejection of claim 25 under 35 U.S.C.
§ 103(a) as unpatentable over Garner and Foley cannot be sustained.

With respect to claim 27, since the system of Garner processes the tracer slips before processing any financial document so as to associate a unique prime pass sequence number with each document, the limitation of "associating a unique group of non-physical, logical tracer document items with the tray of physical document items" when a group of physical tracer document items (tracer slips) are not included cannot be satisfied by the system of Garner because a physical tracer document, namely, a tracer slip, is always present in the system of Garner. Accordingly, the rejection of claim 27 under 35 U.S.C. § 102(e) as anticipated by Garner likewise cannot be sustained.

SUMMARY

The decision of the Examiner to reject claims 25 and 27 is reversed.

REVERSED

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